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| 09/923,702 | 08/07/2001 | Fumitake Yodo | | 1747 |

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,702

Applicant(s)

YODO, FUMITAKE

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office Action (Paper No. 13) has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant's amendment filed December 17, 2003 (Paper No. 14) has been entered. Accordingly, claim 9 remain pending.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 9 is rejected under 35 U.S.C. §102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson '020"). Peterson '020 discloses an accounting system having accounting center (16) and a terminal device (70, 98, and 86). The terminal device comprising: a first memory (within card 88, e.g. memory 91); a second memory (within medium 70, e.g. 79); a first controller (86 and 94 within 86); the controller updates the attributes of the distributed information to an unavailable state (e.g. when the expiration time expires, the desired content again becomes unavailable); the controller updates the accounting points stored in the first memory based upon the distributed information (the change in points is a function of the cost of the content accessed); when accounting points are updated correctly; the controller updates attributes of the distributed information from an unavailable state to the available state (i.e. the user can access the desired information and the charge for that access is deducted); and a second controller (modem). The accounting center comprises a third controller (the personal computer ("PC")) adapted to carry out an account processing (updating a user's account such as purchasing more points, inquiring into the number of points available, or receiving points for returned items, etc.) based upon the accounting points transmitted from the terminal device.

6. Claim 9 is alternatively rejected under 35 U.S.C. §102(a) as being anticipated by Peterson. See the analysis above.

Claim Rejections - 35 USC §103

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 9 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '020 in view of Goldman (U.S. 5,629,867).¹ It is the Examiner principle position that claim 9 is anticipated because of the inherencies involving the functional language (*e.g.* "a third controller configured to carry out an other accounting processing").

If not inherent, Goldman teaches that although only one processor (10) is required, to provide optimum performance, a processor system using two processors (10 and 12) is preferred (column 4, lines 38-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 as taught by Goldman to include a third controller as a redundant processor. Such a modification would have provided redundancy such that if one processor failed, the other processor could immediately take over without interruption.

Moreover, the claimed functions performed by "a third controller" in claim 7 could easily be performed by controller (32) in Peterson '020. Applicant is reminded that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).² In this case, it is the Examiner's factual determination that duplicating processors (whether its two or three

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

² See MPEP §2144 titled "Legal Precedent Can Provide the Rational Supporting Obviousness ..." for a discussion of how legal precedent can be used as a substitute for a motivational statement in obviousness rejections.

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processors) would not produce new or unexpected results other than to increase processing speed.

9. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. The Examiner maintains his position on claim interpretation issues as noted in the previous office actions.

Response to Arguments

10. Applicant's arguments filed December 17, 2003 (Part of Paper No. 14) have been fully considered but they are not persuasive.

11. Applicant argues "that Peterson '020 fails to show or suggest storing account points in a memory built-in in the terminal device."³ The Examiner has again carefully reviewed Peterson '020 and respectfully disagrees. Peterson '020 shows other embodiments where the memory is integral.

12. Applicant's remaining arguments have been considered but are also found unpersuasive.

Conclusion

13. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

³ Applicant's Arguments in filed December 17, 2003, Paper No. 14, page 4, ¶5.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (Paper No. 14 beginning on page 4) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁴ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer

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whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Patent Examiner
Art Unit 3627

AJF
May 17, 2004

⁴ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.